

Action, on page 7, rejects claims 4-8 and 17 under 35 U.S.C. §103(a) as being unpatentable over Takaoka in view of Sato and further in view of U.S. Patent Application Publication No. 2001/0053295 to Kujirai et al. (hereinafter "Kujirai"). These rejections are respectfully traversed.

Claim 1 recites an image processing apparatus comprising: an image processing unit for performing predetermined image processing upon first image data so as to obtain second image data; an image storage unit for storing said second image data; and an image combining unit for combining a plurality of image data, wherein: when third image data is present on which said predetermined image processing will be performed, said third image data being image data having identity with said first image data and including a portion different from said first image data, said image processing unit performs said predetermined image processing upon said different portion between said third image data and said first image data so as to generate fourth image data; and said image combining unit combines, of said second image data stored in said image storage unit, a portion corresponding to said third image data other than said different portion with said fourth image data. Claim 14 recites similar features.

Takaoka is directed to an electronic binder builder that composes an integrated electronic document on the basis of the electronic documents of the plurality of kinds of electronic source documents that are held (Abstract). The Office Action alleges that Takaoka teaches many of the features recited in independent claims 1 and 14. The Office Action concedes, however, that Takaoka does not explicitly disclose "said image combining unit combines, of said second image data stored in said image storage unit, a portion corresponding to said third image data other than said different portion with said fourth image data." The Office Action asserts that Takaoka discloses, in Figs. 7-14, that various pages of documents can be combined in any order using a drag and drop method. The Office Action

concludes that combining documents into an electronic binder can be considered to reasonably correspond to the recited combining unit. This analysis fails for at least the following reasons.

First, Takaoka teaches an electronic binder builder that composes an integrated electronic document on the basis that the electronic documents of the plurality of kinds of electronic source documents that are held (Abstract). Claim 1 recites, in part, performing predetermined image processing upon first image data so as to obtain second image data, an image storing unit for storing said second image data, and an image combining unit for combining a plurality of image data, wherein third image data is present on which said predetermined image processing will be performed ... upon said different portion between said third image data and said first image data so as to generate fourth image data. Creating a binder of documents, whether PDF or other format, cannot reasonably be considered to correspond to combining image data to generate a fourth image, because a combination of files is different from a combination of portions of images used to generate a final image.

Second, the Office Action alleges that Takaoka, at paragraph [0066], lines 6-8, teaches that thumbnail images are created which allegedly correspond to the recited second image data. It is unreasonable for the Office Action to consider that the second image data corresponds to the thumbnail image in Takaoka, because the thumbnail image in Takaoka is not combined to a portion corresponding to a third image data so as to generate fourth image data. In other words, the result in Takaoka is a file with multiple documents, or files, combined within it that is organized by moving thumbnails via a drag and drop process in a user interface as opposed to the final fourth image data that results from the processing apparatus recited in claim 1.

For at least the foregoing reasons, Takaoka, or any combination of Takaoka with Sato or Kujirai, cannot reasonably be considered to teach, or to have suggested all the

combinations of features positively recited in at least independent claims 1 and 14. Further, claims 2-13 and 15-19 also would not have been suggested by Takaoka, or Takaoka in combination with any of the other applied references based at least on the respective dependence of these claims, directly or indirectly, on independent claims 1 and 14, as well as for the separately patentable subject matter that each of these claims recites.

Applicants' representatives presented the above arguments to Examiner Garcia during the December 11 telephone interview. The Examiner indicated that he would consider Applicants' position upon submission of a formal response.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the Applicants' undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:
Petition for Extension of Time

Date: December 29, 2008

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